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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/509,808

08/24/2000

Roland Fischer

F-6485

9821

7590

04/06/2007

Jordan & Hamburg
122 East 42nd Street
New York, NY 10168

EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/509,808	Applicant(s) FISCHER ET AL.	
	Examiner Lawrence D. Ferguson	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-28, 30 and 31 is/are pending in the application.
 4a) Of the above claim(s) 32-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-28, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed December 28, 2006.
Claim 24 was amended rendering claims 24-28 and 30-31 pending with claims 32-46 withdrawn as a non-elected invention.

New Matter - 35 U.S.C. 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 2 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 24, the phrase, 'reduced degree of polymerization' is not supported by the specification.

The Examiner was not able to find support for the added limitation discussed above at the cited portions of the specification.

Claim Rejections – 35 USC § 103(a)

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 24-28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palanos (U.S. 4,126,500).

Palanos discloses a wood component, which is engraved with a laser resulting in some of the wood being vaporized and leaving a depressed region (column 1, lines 55-61). Because the wood is engraved with a laser, it would have been obvious to one of ordinary skill in the art that the area of wood cut with the laser to have an altered property in geometrically defined near surface areas as compared with the original state of the wood and for those areas to have properties of solidified wood melts substantially free from pyrolytic degradation products and having a reduced degree of polymerization and increased plasticization when compared with the original state of the wood. It would have also been expected for the wood melts to include cellulose, lignin and hemicellulose and to be visually different from the original state of wood with respect to optical properties, absorptivity, reflectivity, diffusing power and luster and to have an altered deformation behavior when compared to the original state of the wood. Figures 1-3 shows substances (13) incorporated into the solidified wood melt area (11).

In instant claim 24, the phrase, "being created by exposure of at least a portion of the article of wood to an increased temperature which raises the wood comprising said at least a portion of the article of wood above a melting point thereof" introduces a process limitation to the product claim. Additionally, in instant claim 25, the phrase "cell walls melted in one or several cutting directions" also introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims. In claim 24, the phrase, "caused by short time high energy input into the wood component resulting from electromagnetic waves in the form of laser light having a duration of up to 50ms" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform.

Although Palanos does not explicitly disclose the melted areas having a higher hardness and abrasion resistance than the non-melted wood as in instant claim 27, these claimed features are directly related to the melted wood parts. Since Palanos teaches the same components as Applicant, these features would be expected, absent any evidence to the contrary.

Claim Rejections – 35 USC § 103(a)

5. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Palanos (U.S. 4,126,500) in view of Hashimoto (U.S. 5,784,805).

Claim 24 is relied upon as above. Palanos does not explicitly disclose the incorporated substances into the solidified wood melts are pigments. Hashimoto teaches conventionally coloring melted wood (column 4, line 65 through column 5, line 11). It would have been obvious to one of ordinary skill in the art to color a solidified wood-melt, as taught in Hashimoto, in the engraved wood of Palanos to improve the aesthetic features of the wood material.

Response to Arguments

6. Applicant's arguments of rejection made under 35 U.S.C. 103(a) as being unpatentable over the Hashimoto (U.S. 5,485,685) are moot based upon grounds of new rejection.

Applicant's arguments of rejection under 35 U.S.C. 103(a) as being unpatentable over the Hashimoto (U.S. 5,784,805) are moot based upon grounds of new rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).



Lawrence Ferguson
Patent Examiner
AU 1774



RENA DYE
SUPERVISORY PATENT EXAMINER

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